

No. 14399

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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D & H ELECTRIC COMPANY, a corporation,

*Appellant,*

*vs.*

M. STEPHENS MFG. INC., a corporation, and JACK MC-  
LOUGHLIN, doing business as McLoughlin Sales,

*Appellees.*

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APPELLANT'S PETITION FOR REHEARING.

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## APPELLANT'S PETITION FOR REHEARING.

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Appellant respectfully petitions for a rehearing in this case upon the grounds that, in sustaining the judgment of the trial court, this Court:

1. Has denied to appellant the proper application of the doctrine of file wrapper estoppel which it has applied in prior cases;
2. Has misconstrued the structure and mode of operation of the accused devices of Exhibits 18-22, 33 and 34; and
3. Has failed to review the judgment below with respect to the accused device of Exhibit 17.

When the File Wrapper Proceedings Are Construed in the Light of the Inventive Contribution of the Patent in Suit, the State of the Prior Art, and the Prior Decisions of This Court, It Is Clear That the Court Has Denied to Appellant a Proper Application of the Doctrine of File Wrapper Estoppel.

The effect of the Court's decision is to apply the doctrine of file wrapper estoppel in such a way as to deny to appellant an interpretation of the patent claim which embraces the improvements actually invented and not disclosed in the prior art. This effect is contrary to the doctrine as heretofore defined and applied by this Court. For instance in *Angelus Sanitary Can Machine Co. v. Wilson*, 7 F. 2d 314, 318 (9 Cir.), the Court defined the doctrine as follows:

"Conceding the principle that, by amending, Wilson is limited to the form and language of the claims as allowed, nevertheless, he is not limited to any detailed specific construction to avoid any reference cited against it, *nor is he estopped from claiming by the amended claim every improvement and combination which he has invented and which was not disclosed by those references.* We regard claim 2, in the element of encircling means, as entitled to a construction which includes a fairly liberal range of equivalents. The difference in the use of a mechanical equivalent does not avoid infringement. In *Eibel Process Co. v. Paper Co.*, 261 U. S. 45, 43 S. Ct. 322, 67 L. Ed. 523, the Court, through the Chief Justice, clearly reiterated the doctrine that where an inventor, though not a pioneer in the sense of having created a new art, has made a very useful discovery which has substantially advanced the art, his patent, though but an improvement on an old machine,

may be entitled to liberal treatment. That same principle was applied by this Court in *Smith Cannery Co. v. Seattle Astoria Iron Works* (C. C. A.), 261 F. 87."

The doctrine is likewise defined and applied by other Circuit Courts of Appeal, as shown, for instance, by the following cases:

*R. Hoe & Co. v. Goss Printing Press Co.*, 30 F. 2d 271, 275 (2d Cir.);

*International Cellucotton Products Co. v. Sterilek Co., Inc.*, 94 F. 2d 10 (2d Cir.);

*Farrington v. Haywood*, 35 F. 2d 628, 630 (6th Cir.);

*Ceramic Process Co. v. General Porcelain Enameling & Mfg. Co.*, 129 F. 2d 803 (7th Cir.);

*Binney & Smith Co. v. United Carbon Co.*, 125 F. 2d 255 (4th Cir.);

*Dietel v. Unique Specialty Corp.*, 54 F. 2d 359 (2d Cir.).

Thus, to properly apply the doctrine to the facts of this case, we must measure what the patentees invented against what was shown by the prior art, Exhibit C.

In essence, the invention is the effecting of self-locking of the coupling device in the conduit by providing the coupling with ribs arranged to have a combination of two characteristics, namely, the ribs must be so disposed in relation to the major axis as not to match the spiral of the convolutions of the conduit, and they must be so staggered and spaced as to define a helical angle greater than that of the conduit.

On the other hand, the prior art merely disclosed couplings having conventional continuous or interrupted

screw threads fitting or mating with the convolutions of the conduit, both as to their angularity to the major axis and as to their helical angle.\*

In the preferred specific form of the invention shown in the patent drawing, the ribs are disposed precisely at an angle of 90° to the major axis. However, particularly when the ribs are also spaced and staggered to define the greater helical angle, the angularity of the ribs to the major axis may be varied without changing the mode of operation, so long as that angularity is not the same as that of the convolutions of the conduit. [R. 91.]

The Court apparently predicated its application of the doctrine of file wrapper estoppel upon its interpretation of the file wrapper proceedings [Ex. D] relating to the cancellation of claims 7 and 10 and the amending of claim 2, of the application, which latter claim became the claim of the patent in suit.

It must be borne in mind, however, that, as originally presented in the application, neither of those claims de-

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\*While, in its opinion, the Court states that the prior art reveals the principle of joining threads or ribs of relatively different helical angles, the opinion does not identify any such art and appellant has been unable to find any such teaching in any of the prior art. It is believed that this statement in the opinion is based upon a misinterpretation of the following statement appearing in prior art patent 1,494,524 (p. 1, line 86 *et seq.*): "*Interrupted threads 12 are provided on an enlarged portion 13 of section 2 and these threads have a pitch less than that of the threads 5.*" However, examination of the patent shows that the quoted statement does not refer to the joining or interengagement *with each other* of two parts having threads of different helical angles. The patent shows two gun-barrel sections 1 and 2 coupled together by a collar 14. While the threads 5 of barrel section 1 have a pitch different from the pitch of threads 12 of section 2, the threads 5 engage with threads in the *collar* having the same pitch as threads 5, while threads 12 of section 2 engage with other threads in the collar having the same pitch as threads 12. That is quite a different thing from interengaging *with each other* threads of different helical angles.



scribed the ribs as such and neither of them in any way defined the angle of the ribs to the major axis. Rather, the claims merely described the ribs in broad, generic terms, as “protuberances” or “means.” Consequently, as the claims were originally presented, they did not in that respect distinguish over the conventional mating screw threads of the prior art.

Since the prior art merely showed conventional mating screw threads, in order for the patentees to distinguish over the prior art it was only necessary to amend the claim to specify the “ribs” and to specify that their angle to the major axis was not such as to match the corresponding angle of the conduit convolutions.

To effect that distinction without unnecessarily limiting the claim to the ribs being disposed precisely at right angles to the major axis, the patentees amended claim 2 to recite “ribs extending *substantially* at right angles to the major axis” and to recite that the ribs were disposed in “staggered relation.” As so used, the term “substantially” was obviously designed to give to the claim the latitude of equivalency which embraced the gap between ribs disposed precisely at right angles and ribs which were disposed at an angle to the major axis which matched the spiral of the convolutions of the conduit.

It is that range of equivalency which the Court has denied to the claim because of what appears to be a misapplication of the doctrine of file wrapper estoppel.

If the claims numbered 7 and 10 of the application had been likewise amended, they would have been in substance the same as the retained claim 2. Consequently, claims 7 and 10 were cancelled.

However, it is well settled in this and other Circuits that the surrender of a broad or generic claim by an inventor does not deprive him of a range of equivalents for a retained narrower claim which is coextensive with the latitude permitted by the disclosures of the prior art.

*Binney & Smith Co. v. United Carbon Co., et al., supra;*

*Research Products Co. v. Tretolite Co.,* 106 F. 2d 530, 535 (9th Cir.).

In the instant case, that latitude is the difference between a *precisely* right angular disposition of the ribs to the major axis and an angular disposition to the major axis which would match that of the convolutions of the conduit.

A careful study of the cases cited in the Court's opinion on the issue of file wrapper estoppel shows that there is no variance between those cases and the proper rule as above discussed. On the contrary, the facts of those cases were not at all analogous to those here involved. For instance, in the case of *Tampax, Inc. v. Personal Products Corp.*, 123 F. 2d 722, 723 (2nd Cir.), quoted from in the opinion, the inventor used the term "*convoluted*" in the claim. The Patent Office required the inventor to amend to explain what he meant by that term, and, in response to this requirement the inventor amended to recite in detail a particular kind of convolution which was necessary to distinguish over the prior art. The Court, of course, properly held in that case that the claim was limited to that particular kind of convolution.

That the Second Circuit does not limit a patent claim, under the doctrine of file wrapper estoppel, to a greater extent than is necessary to prevent it from being the

same as the prior art, is clearly apparent from the following remarks of Judge Learned Hand in *R. Hoe & Co. v. Goss Printing Press Co.*, *supra*:

“We have repeatedly said that we will not look to the file wrapper for estoppels, except in case the patentee tries to expand his claim by omitting an element which leaves it identical with one which he has abandoned.”

If, in the instant case, the Patent Office had required the patentees to amend to explain precisely what was meant by the term “substantially” and if, in response to that requirement, the patentees had amended to state that it meant that the ribs must be disposed *precisely* at right angles excepting only for such slight variances as might result from imperfections and manufacturing tolerances, the claim properly should be limited to the construction which the Court has given to the claim. *But, of course, the file wrapper does not show any such explanation, limitation or meaning.*

The Courts construe patent claims to embrace such slight variances as might result from imperfections and manufacturing tolerances, *whether or not the claims so state.*

*Musher Foundation, Inc. v. Alba Trading Co., Inc.*, 150 F. 2d 885 (2nd Cir.).

Consequently, when the patentees here inserted the word “substantially” before “right angular” it must be presumed that they meant something *more than* slight variances resulting from imperfections and manufacturing tolerances. Otherwise the word “substantially” would be superfluous in the claim.

Appellant therefore respectfully submits that the term “substantially at right angles” as used in the claim, in

combination with the feature of the greater helical angle, should be construed to embrace a variation from the right angular of the order of  $1^{\circ}$  to  $5^{\circ}$  which does not change the mode of operation. If this proper interpretation of the claim is not applied, the effect will be to deprive appellant of the fruits of a useful invention which has advanced the art.

Courts should be careful to avoid application of the doctrine of file wrapper estoppel in a manner to defeat the real discovery which the inventor has contributed to the art.

*Barrel Fitting & Seal Corporation of America v. American Flange & Mfg. Co.*, 74 F. 2d 569, 571 (7th Cir.).

### **In Sustaining the Judgment Below the Court Has Misconstrued the Accused Devices and Their Mode of Operation.**

It is realized that an unusual burden is placed upon the Court in this case in construing the mode of operation of the accused devices. Normally, in a patent case, the Court is able visually to observe the actual operation, but in the instant case that is impossible because flexible conduit cannot be sectioned axially to provide operative demonstration models which can be viewed in all stages of operation, the reason being that, if sectioned, the convolutions will separate. As a result, in the models before the Court the coupling is necessarily concealed within the conduit during the operation which effects the self-locking.

Moreover, while, on its face, the invention might appear to be very simple, in reality the significance of the combination of features and mode of operation which provided the self-locking are difficult for one not particularly

skilled in engineering to understand. Even a skilled mechanic must rely upon meticulous measurements and computations to understand them.

In fact, it is submitted that an examination of the testimony of appellee's only witness, Mr. Friedman, shows that even he did not understand the mode of operation of the accused devices. Admittedly, appellee made its device after seeing appellant's commercial embodiment of the patented invention on the market. [R. 123.] The first device [Ex. 17] made by appellee was an *exact duplicate* of the patented device in every particular. Then, for the purpose of providing a subterfuge upon which to lean if sued for infringement, appellee made the slight but inconsequential change of varying the angularity of the ribs from  $1^{\circ}$  to  $5^{\circ}$  from the right angular and by slightly thickening the ribs,\* while precisely retaining the other important feature of the combination, namely, the feature of the greater helical angle. Appellee's witness, Mr. Friedman, ventured several different theories as to the mode of operation [R. 122] but admitted that he was unskilled in mechanics [R. 123] and that he had not measured and was not capable of measuring the angles of the ribs [R. 131] and that his conclusions were mere assumptions. [R. 123.] On the other hand, appellant's qualified expert testified that the accused devices functioned by the same mode of operation as did the patented devices [R. 91-93] which testimony he based upon his own meticulous measurements and computations which he translated into illustrative charts. [Exs. 25, 28.] He also testified that particularly since the accused devices utilized ribs arranged to define a greater helical angle,

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\*The patent claim, however, does not prescribe any specific thickness for the ribs.

the slight variation of  $1^{\circ}$  to  $5^{\circ}$  to the right angular did not in any way change the mode of operation. [R. 91.] It is submitted therefore that in a case like this, in which the Court is unable to have its own visual inspection of the mode of operation, the only reliable evidence before the Court as to the mode of operation is that of appellant's qualified expert based upon actual measurements and computations.

In sustaining the judgment of non-infringement, this Court stated, in its opinion, that the accused devices used interrupted screw threads which fit the convolutions of the conduit. However, not only is this conclusion directly contrary to the only competent evidence in the case, but an inspection of the illustrative charts [Exs. 25, 28], the accuracy of which is not questioned, shows that this would be impossible.

For instance, the drawing included in the opinion, which appears to be a reproduction of Exhibit 28, shows that the ribs of the accused device define a  $12^{\circ}$  helical angle while the convolutions of the conduit only have a  $9^{\circ}$  helical angle. Obviously it would be impossible for ribs having a  $12^{\circ}$  helical angle to *fit* convolutions having a  $9^{\circ}$  helical angle. Also, an inspection of that drawing shows that the ribs of the accused device vary from the right angular by only  $3^{\circ}$  while the convolutions of the conduit are pitched at  $9^{\circ}$ . It is clear therefore that those ribs would not mate with or fit the conduit in the manner of a screw thread.

There is a still further reason, pointed out by appellant's expert at R. 96-97, why the ribs of the accused devices cannot function or be considered as interrupted screw threads. That is, that the angle of the slight spiral given to the ribs of the accused device, in relation to



their staggered relationship and spacing, is such that neither of the ribs would align with or intersect an end of either of the other ribs if extended around the coupling in the manner of screw threads, so that each of the ribs would have to be considered separately from the other ribs instead of all the ribs combining to form continuations of a single thread, as would be necessary to enable them to function as a conventional interrupted screw thread.

We find therefore that the only reliable evidence before the Court with respect to the construction and mode of operation of the accused devices shows that the devices of Exhibits 18-32, 33 and 34 combine the substance of the combination of the patent claim in suit and function by the same mode of operation, and therefore clearly infringe.

While the Court, in its opinion, stated that the slight angular variation of the ribs of the accused devices invokes "by appellant's admission, an entirely different principal of operation," the Court failed to point out what it construes to be such an admission and appellant is unable to find any such admission in the record. In fact, if appellant had felt that the mode of operation of the accused devices was different, it would not have taken this appeal at all. The evidence is that the mode of operation is the same, as shown by the following quotation from appellant's expert's testimony at R. 91:

"Now, I have found by demonstration here where I have had these exhibits in my possession for the past week and put (70) them together and took them apart time and time again, that there is no difference in the action, the reason for it being that the angular relation of the rib does not alter its helical angle struck from centers.

“The only possible difference in the action—the *mode of operation is identical*, but in the action, by reason of the rib being at an angle, its leading edge, as compared with one that is perpendicular, could possibly meet with the wall of a convolution of the spiral, let us say, a moment sooner, quicker.”

In *Farrington v. Haywood, supra*, a case involving analogous facts, the patent was for a combination of which one element was a stirrer-blade. As originally presented in the application, the claim merely recited “a stirrer-blade.” As so worded, the claim was rejected on prior art showing collapsible or foldable stirrer-blades. The inventor then amended the claim to recite that the stirrer-blade was “flat” and “substantially rigid.” The accused device used the combination but used a stirrer-blade which was not rigid, although it functioned to some extent as a rigid blade. In holding infringement, the Court said:

“There was obviously no intention upon his (the patentee’s) part to limit his claim beyond what was necessary to distinguish the devices of the prior art and the language used does not so require. Under these circumstances this Court has frequently held that infringement is not avoided by a purely literal departure from the apparent limitation of the claims (citing cases). Under frequently arising normal conditions, one end of the defendant’s stirrer bar is pivoted to one head and the other end is located adjacent the hole and said bar is insertible through the bunghole. At such times it is functionally and operatively integral and ‘substantially rigid.’ There is a substantial identity of form and method of operation with only ‘such variations as are consistent with its being in substance the same thing.’ *Burr v. Duryee*, 1 Wall. 531, 573, 17 L. Ed. 650; *Sanitary Re-*



frigerator Co. v. Winters (decided October 14, 1929), 50 S. Ct. 9, 74 L. Ed. .... It will therefore infringe at some stage of its operation. It is unnecessary that it infringe at all stages.”

### **The Court Failed to Review the Trial Court’s Ruling With Respect to the Accused Device of Exhibit 17.**

The accused device of Exhibit 17 was purchased by appellant in the open market [R. 138], and appellee admits that he made those devices and passed them to the trade, although he claims to have passed them out only as “samples.” [R. 106]. Exhibit 17 conforms in precise detail to the claim of the patent in suit, the ribs not varying in the slightest from the right angular. In view of appellee’s statement that he made and distributed the devices of Exhibit 17 as “samples,” but did not sell them, the trial court held that they did not infringe.

A patent gives the patentee the right to exclude others from making, using or selling the patented item. (*Six Wheel Corporation v. Sterling Motor Truck Co. of California*, 50 F. 2d 568 (9th Cir.)), and, merely making a patented item without selling it is an infringement.

*Carter Crume Co. v. American Sales Book Co.*,  
124 Fed. 903.

### **Conclusion.**

It is respectfully submitted therefore that a rehearing will avoid a serious miscarriage of justice.

Respectfully submitted,

MASON & GRAHAM,

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*Attorneys for Appellant.*

**Certificate of Counsel.**

I, Collins Mason, counsel for Petitioner in the above entitled action, hereby certify that the foregoing petition for rehearing of this cause is presented in good faith and not for delay, and in my opinion is well founded in law and in fact, and proper to be filed herein.

COLLINS MASON,  
*Attorney for Petitioner.*